

REMARKS

This is a complete response to the outstanding non-final Office Action mailed June 22, 2006. Claim 32 has been amended herein. No new matter has been added. Upon entry of the enclosed claim amendments, claims 21-44 remain pending in the present application.

The Applicant traverses all of the objections and rejections of the Office Action. Applicant appreciates the Examiner's review of the above-identified patent application and respectfully requests reconsideration and allowance in view of the above amendments and following remarks.

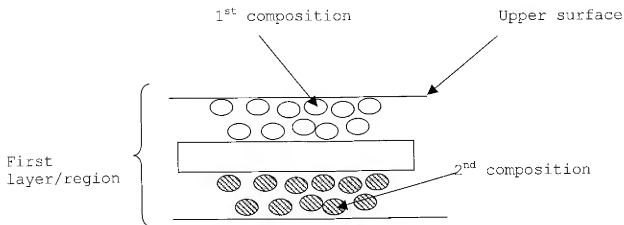
I. Withdrawal of previous restrictions and objections

Applicant appreciates the Examiner's reconsideration and withdrawal of the previous claim objections under 112 and the restriction requirement.

II. Response to new claim objections under 35 USC 112 2nd paragraph

A. Claim 21

Applicant does not understand how the Office Action contends that the cited claim language of claim 21 is indefinite. Claim 21 recites, "a first region having a first layer of a second asphalt composition contacting an upper surface of said first region and a second layer of an adhesive composition contacting a lower surface of said first region." The Office Action asserts that it is not possible for a layer that is a component of a region to be in contact with the upper surface of that region. However this assertion is incorrect as illustrated in the diagram below.



As demonstrated, the 1st composition is a component of the first layer/region. The 1st composition is also contacting the upper surface of the first layer/region. Conversely the 2nd composition is not contacting the upper surface. The upper

surface is defining the boundary of the first layer/region. The claim language of claim 21 particularly points out and distinctly claims the subject matter which Applicant regards as the invention. Therefore, the 112 2nd paragraph rejection with respect to claim 21 should be withdrawn.

B. Claim 32

Applicant has amended claim 32 to correct any indefiniteness. The amended claim language of claim 32 correctly recites to said upper and said lower surface introduced as the first element of the first substrate. Therefore, the 112 2nd paragraph rejection with respect to claim 32 should be withdrawn.

III. Response to claim rejections based on anticipation

In the Office Action, claims 21, 22, 24, 29, 32-34, 36, 41, and 44 have been preliminarily rejected as anticipated under 35 U.S.C. § 102(b). Specifically claims 21, 22, 24, 29, 32-34, 36, 41, and 44 have been rejected under 35 U.S.C. § 102(b) by U.S. Patent No. 5,096,759 to Simpson et al. (hereinafter, "Simpson").

A. Claim 21 and 44

There is nothing in Simpson which teaches or suggests providing a region of an edge region of the substrate 92 with a lower surface free of said second asphalt composition. Claim 21 recites, "a second region disposed along at least a first edge of said substrate, said second region having an upper and a lower surface substantially free of said first and said second asphalt compositions." The Office Action references coating item 24 disclosed in col. 3, lines 25-29 and col. 4, lines 36-39 as disclosing a first region having a first layer of a second asphalt composition. The Office Action then references Fig. 9 element 92 as having an upper and a lower surface substantially free of the second asphalt composition. Simpson does not teach a combination of regions as asserted by the Office Action. The Office Action is misinterpreting the teaching of Simpson and inappropriately combining selective teaching for the sole purpose of reading them on Applicant's claims. The Examiner has the burden of identify where the claim elements are taught and that that the combinations of elements are correctly construed from the reference. Simpson does not teach a combination of regions as recited by Applicant's claimed invention. For at least these reasons, the anticipation rejection of claim 21 by Simpson should be withdrawn and claim 21

allowed.

Since claim 44 also contains a similar limitation, the anticipation rejection of claim 44 by Simpson should also be withdrawn and claim 44 also allowed. Applicant submits that none of the references cited disclose or suggest the limitations missing from Simpson as discussed above. Therefore the obviousness rejections previously submitted with regard to dependent claims should not apply. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the claim rejection.

B. Claims 22-31

The Applicant respectfully submits that since claims 22-31 depend on independent claim 21, claims 22-31 contain all limitations of independent claim 21. Since independent claim 21 should be allowed, as argued herein, pending dependent claims 22-31 should be allowed as a matter of law for at least this reason.

In re Fine, 5 U.S.P.Q.2d 1596, 1608 (Fed. Cir. 1988).

C. Claim 32

In addition to the above arguments of claim 21, Simpson clearly states the entire bottom surface of the substrate 92 is coated with the adhesive layer 94, even at the edges where the underlayment 90 overlaps. There is nothing in Simpson which teaches or suggests providing a region of an edge region of the substrate 92 with a lower surface free of adhesive. Amended claim 32 recites, "a second region disposed along at least said top and said bottom edge regions of said substrate wherein said upper and said lower surfaces within said substrate are substantially free of said first asphalt composition, said second asphalt composition, and said adhesive composition." For at least these reasons, the anticipation rejection of claim 32 by Simpson should be withdrawn and claim 32 allowed. Applicant submits that none of the references cited disclose or suggest the limitations missing from Simpson as discussed above. Therefore the obviousness rejections previously submitted with regard to dependent claims should not apply. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the claim rejection.

D. Claims 33-43

The Applicant respectfully submits that since claims 33-43

depend on independent claim 32, claims 33-43 contain all limitations of independent claim 32. Since independent claim 32 should be allowed, as argued herein, pending dependent claims 33-43 should be allowed as a matter of law for at least this reason. In re Fine, 5 U.S.P.Q.2d 1596, 1608 (Fed. Cir. 1988).

III. Prior Art Made of Record

The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

CONCLUSION

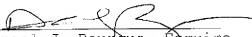
In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and rejections have been traversed, rendered moot and/or accommodated, and that presently pending claims 21-44 are in condition for allowance. Favorable reconsideration and allowance of the present application and the presently pending claims are hereby courteously requested. The examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

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Respectfully submitted,

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